REMARKS

Reconsideration of the present application is respectfully requested in view of the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance. Prior to entry of this response, Claims 1-20 were present in the application, of which Claims 1, 8, 17 are independent. In the Office Action dated September 25, 2007, Claims 6-7 and 15-16 were rejected under 35 U.S.C. § 101 and Claims 1-20 were rejected under 35 U.S.C. § 102(b). Following this response, Claims 1, 3-4, 6-8, and 12-18 remain in this application with Claims 2, 5, 9-11, and 19-20 being canceled without prejudice or disclaimer. Applicant hereby addresses the Examiner's rejections in turn.

I. Interview Summary

Applicants thank Examiners Anwari and Kang for the courtesy of a telephone interview on December 4, 2007, requested by the undersigned to discuss the rejection of the current claims under 35 U.S.C. § 102. During the interview, Applicants asserted that the cited references do not anticipate the claims as currently amended. In addition, the Examiner suggested further amendments, which are incorporated, to further distinguish the claims from the cited references. Furthermore, the Examiner indicated the currently amended claims appear to overcome the cited references. However, a further search of the art is needed and no agreement was reached regarding patentability.

II.   Rejection of Claims 6-7 and 15-16 Under 35 U.S.C. § 101

In the Office Action dated September 25, 2007, the Examiner rejected Claims 6-7 and 15-16 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 6-7 and 15-16 have been amended and Applicants respectfully submit that the amendments overcome this rejection and add no new matter.

III.   Rejection of Claims 1-20 Under 35 U.S.C. § 102(b)

In the Office Action, Claims 1-20 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,283,856 ("*Gross*"). Claims 1, 8, and 17 have been amended, and Applicants respectfully submit that the amendments overcome this rejection and add no new matter.

Amended Claim 1 is patentably distinguishable over the cited art for at least the reason that it recites, for example, "wherein identifying the rule to the user comprises displaying a second user interface dialog box comprising a list identifying each of the at least one electronic messages indicating which of the at least one condition that has been satisfied." Amended Claims 8 and 17 each includes a similar recitation. Support for these amendments can be found in the specification at least on page 8, line 5-page 10, line 5.

In contrast, *Gross* at least does not disclose the aforementioned recitation from Claim 1. For example, *Gross* merely discloses informing an electronic mail application program interface (e-mail APR) 18 when a new message packet is received over a network at a host having a mail messaging system. (*See* col. 7, lines 31-35.) In *Gross*, e-mail API 18 informs a messaging transport access layer 16 that there is an

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information packet comprising a message. (*See* col. 7, lines 36-37.) Messaging transport access layer 16, in *Gross* receives the information and stores the message. (*See* col. 7, lines 38-41.) *Gross'* message access transport layer 16 also calls an event manager 24 that creates a NEW message event having a date and time received and a UID identifying the message stored. (*See* col. 7, lines 41-45.) Event manager 24 invokes a persistent event manager 26 that stores the created NEW message event in a persistent event queue 28 for processing by the event manager substantially on a first-in first-out (FIFO) basis. (*See* col. 7, lines 45-49.) Accordingly, *Gross* merely discloses transferring an information packet through various layers to create a NEW message event for use by an event manager on a FIFO basis. Consequently, *Gross* does not disclose displaying a user interface object including a list identifying electronic messages satisfying conditions. Rather *Gross* merely discloses creating a queue for processing electronic messages. In addition, *Gross* is silent regarding displaying a list of messages satisfying conditions.

Gross does not anticipate the claimed invention because *Gross* at least does not disclose "wherein identifying the rule to the user comprises displaying a second user interface dialog box comprising a list identifying each of the at least one electronic messages indicating which of the at least one condition that has been satisfied," as recited by amended Claim 1. Amended Claims 8 and 17 each includes a similar recitation.

Furthermore, amended Claim 1 is patentably distinguishable over the cited art for at least the reason that it recites, for example, "performing an evaluation to determine whether the at least one condition is satisfied, wherein performing the evaluation

comprises performing the evaluation when the at least one electronic mail message has been received." Amended Claims 8 and 17 each includes a similar recitation. Support for these amendments can be found in the specification at least on page 8, line 5-page 10, line 5.

In contrast, *Gross* at least does not disclose the aforementioned recitation from Claim 1. For example, *Gross* merely discloses a timer integrated with a rule based messaging system and used to implement PERIODIC, i.e. timed or tickler rules. (*See* col. 5, lines 44-47.) The PERIODIC occurrence triggers corresponding rules EVERY once an hour/day/week/month, as specified in an event portion of the rule. (*See* col. 5, lines 47-49.) In *Gross*, the PERIODIC occurrence is limited to a specified TIMER time by providing a TIMER operand. (*See* col. 5, lines 53-55.) A TIMER event is defined in a data structure and includes a date and time when the event is to get noticed. (*See* col. 5, lines 56-58.) Accordingly, *Gross* merely discloses a timer bases system where events happen at preset times regardless of whether an electronic message is received. Consequently, *Gross* does not disclose performing evaluations when an electronic mail message is received. Rather *Gross* merely discloses implementing a rule at a preset time.

Gross does not anticipate the claimed invention because *Gross* at least does not disclose "performing an evaluation to determine whether the at least one condition is satisfied, wherein performing the evaluation comprises performing the evaluation when the at least one electronic mail message has been received," as recited by amended Claim 1. Accordingly, independent Claims 1, and 8, and 17 each patentably

distinguishes the present invention over the cited art, and Applicants respectfully request withdrawal of this rejection of Claims 1, 8, and 17.

Dependent Claims 3-4, 6-7, 12-16, and 18 are also allowable at least for the reasons described above regarding independent Claims 1, 8, and 17, and by virtue of their respective dependencies upon independent Claims 1, 8, and 17. Accordingly, Applicants respectfully request withdrawal of this rejection of dependent Claims 3-4, 6-7, 12-16, and 18.

IV.   Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 13-2725.

Respectfully submitted,

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